

REMARKS

I. Status of the Claims

Claims 1-6 and 8-11 are currently pending in the present application. Support for the amendment to claim 1 can be found in canceled claim 7. Also, claim 1 has been amended to require that the radical at R3 is unsubstituted. Thus, there is no issue of new matter.

Reconsideration of this application, as amended, is respectfully requested.

II. Claim Rejections – 35 USC §103 (a)

The following Rejections (A)-(C) are pending:

- (A) Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cameron (WO 90/11317) in view of Nalwa (Journal of Materials Science, 26 (1991) p. 1683-1690);
- (B) Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cameron in view of Nalwa and Oka (JP-07-090179); and
- (C) Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cameron in view of Nalwa and Kin (JP-11-185962).

Applicants respectfully traverse the Rejections (A)-(C).

In order to further distinguish the present invention from the teachings of the cited references, Applicants have amended claim 1 to recite the subject matter of claim 7. As such, Rejections (A) and (C) are rendered **moot**. Applicants now comment on Rejection (B).

Legal Standard for Determining Prima Facie Obviousness

MPEP 2141 sets forth the guidelines in determining obviousness. First, the Examiner has to take into account the factual inquiries set forth in *Graham v. John Deere*, 383 U.S. 1, 17, 148

USPQ 459, 467 (1966), which has provided the controlling framework for an obviousness analysis. The four *Graham* factors are:

- (a) determining the scope and content of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating any evidence of secondary considerations.

Graham v. John Deere, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966).

Second, the Examiner has to provide some rationale for determining obviousness. MPEP 2143 sets forth some rationales that were established in the recent decision of *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).

As the MPEP directs, all claim limitations must be considered in view of the cited prior art in order to establish a *prima facie* case of obviousness. See MPEP 2143.03.

Distinctions over the Cited Reference

It appears that the Examiner misunderstands the teachings of Cameron. The Examiner asserts that "Cameron discloses that polyaniline polymers (Formula C-1) can be linked with a polyimide and the copolymer can be in a solvent (page 4, lines 5-17)."

In this regard, Cameron discloses the following matter.

"...disclosed a conductive polymer blend formed by first reacting ...polyaniline... with a carbonyl anhydride... to form a conductive polymer containing polyimide-like groups covalently linked to nitrogen atoms of the base-type polymer, mixing such conductive polymer with non-conductive polyimide in a suitable solvent, and forming a conductive continuous phase blend of the polyimide and the conductive polymer."
(Emphasis added).

As noted above, polyaniline is subjected to a reaction with a carbonyl anhydride in order to prepare a conductive polymer having polyimide-like groups. That is, polyaniline itself is not used for preparing a blend of a polyimide and a conductive polymer.

On the other hand, the inventive varnish contains each of an oligoaniline derivative and a polyamic acid (a polyimide precursor) or polyimide.

Accordingly, significant patentable distinctions exist between the present invention and the teachings of the cited references.

Reconsideration and withdrawal of Rejection (B) are respectfully requested.

III. Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.


In view of the above amendment, Applicant believes the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Garth M. Dahlen, PhD, Registration No. 43,575 at the telephone number of the undersigned below to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Director is hereby authorized in this, concurrent, and future replies to charge any fees required during the pendency of the above-identified application or credit any overpayment to Deposit Account No. 02-2448.

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Respectfully submitted,

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